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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91177828
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Attachments	MyStore-com 91-177828-MtnStrike-Final 2007-08-15.pdf (7 pages)(85890 bytes) Interpayment Services Limited v. Docters & Thiede-91-119852_2002-01-31.pdf (6 pages)(74346 bytes)

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/Martin R Greenstein/
Martin R. Greenstein

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

SNOCAP, INC.,

Opposer,

v.

TODD MEAGHER,

Applicant.

Opposition No.: 91-177,828

Trademark:
MYSTORE.COM (stylized)
Appln No. **78/853,866**

**OPPOSER’S MOTION TO STRIKE PORTIONS OF
APPLICANT’S ANSWER AND AFFIRMATIVE DEFENSES**

Pursuant to Rule 12 of the Federal Rules of Civil Procedure and Section 506.01 of the Trademark Board Manual of Procedure, Snocap, Inc., (“Opposer”) hereby moves the Trademark Trial and Appeal Board (the “Board”) to strike paragraphs 14, 15, 18 through 20, 22 and 23 of the Answer to Notice of Opposition filed by Todd Meagher (“Applicant”). The basis for this motion is that the allegations and affirmative defenses set forth in those paragraphs are insufficient and improper as a matter of law, and/or are immaterial or irrelevant to this proceeding, and should therefore be stricken.

FACTS

On April 4, 2006 Applicant filed an intent-to-use (ITU) application to register the alleged mark MYSTORE.COM (stylized), claiming a bona fide intent to use the alleged mark for a broad list of services which, after objections by the Examining Attorney, were eventually narrowed to:

Advertising and information distribution services, namely, providing classified advertising space via a global computer network; promoting the goods and services of others over the Internet; providing on-line computer databases and on-line searchable databases featuring classified listings and want ads, in Int. Class 35.

No Amendment to Allege Use has yet been filed.

The basis for the Notice of Opposition is that the alleged mark sought to be registered is descriptive or generic, and that registration thereof will harm Opposer and others by curtailing the right to use the term in a descriptive or generic sense. In his answer, Applicant included the following statements and affirmative defenses that are insufficient as a matter of law, and/or are irrelevant, immaterial or otherwise have no bearing on this case:

FURTHERMORE, Applicant sets forth the following in support of its defense:

14. Trademarks registered on the Principal Register of the United States Patent and Trademark Office which contain the terms MY and STORE, without any disclaimer or claim of acquired distinctiveness regarding both of those terms, include:

<i>Registration No.</i>	<i>Mark</i>
<i>2809162</i>	<i>MYSCHOOLBOOKSTORE</i>
<i>2555965</i>	<i>MY BABY STORE</i>
<i>2628975</i>	<i>MYUNIVERSITYSTORE.COM</i>
<i>2598869</i>	<i>MYBENEFITSTORE</i>
<i>2773847</i>	<i>MYLOCALSTORE</i>
<i>2413861</i>	<i>MY LOCAL HARDWARE STORE!</i>
<i>253 1343</i>	<i>MYBIZWEBSTORE.COM</i>
<i>2663703</i>	<i>MY CORPORATE STORE</i>

15. *Trademarks formerly registered on the Principal Register of the United States Patent and Trademark Office which contain the terms MY and STORE, without a disclaimer or claim of acquired distinctiveness of both terms, include:*

<i>Registration No.</i>	<i>Mark</i>
1253266	MY STORE
1641386	MY STORE
2561645	MY STORE

* * * *

18. *Opposer is barred from relief by the Doctrine of Latches.[sic]*

19. *Opposer is barred from relief by the Doctrine of Estoppel.*

20. *Opposer is barred from relief by the Doctrine of Acquiescence.*

* * * *

22. *Opposer does not have standing.*

23. *The Notice of Opposition fails to state a claim upon which relief may be granted.*

Opposer hereby moves to strike each of these statements and affirmative defenses.

ARGUMENT:

Under Rule 12(f) of the Federal Rules of Civil Procedure, the Board may strike from a pleading any insufficient defense or any redundant, immaterial, or impertinent allegation.

Harsco Corp. v. Electrical Sciences Inc., 9 U.S.P.Q.2d 1570 (TTAB 1988). Although motions to strike are not favored, *id.*, the listed allegations and defenses have no bearing on the possible issues in this case. Thus, the Board should strike these paragraphs now, before the parties have to spend time and money on costly discovery, testimony, argument and briefing.

I. Paragraphs 14 and 15 Make Immaterial Allegations and Should be Stricken.

Paragraphs 14 and 15 of the Answer do no more than list asserted third-party registrants and users. As such, those paragraphs should be stricken under *McCormick & Co. v. Hygrade Products Corp.*, 124 U.S.P.Q. 16 (TTAB 1959); see also, Trademark Board Manual of Procedure §506.01, footnote 98: "*recital of evidentiary material, namely, list in defendant's pleading of asserted third-party registrations and users, stricken*".

Furthermore, as Applicant admits, the registrations listed in paragraph 15 are all expired, and thus have no bearing on apparent issue for which Applicant presents them. Paragraph 15 should be stricken for this reason as well.

II. Paragraphs 18-20 Assert Improper Defenses and Should be Stricken.

In paragraphs 18-20 of the Answer, Applicant asserts the affirmative defenses of laches, estoppel and acquiescence. However, as the Board has previously stated:

It is well settled that when the right to register is at issue, the affirmative defenses of laches, estoppel and acquiescence do not begin to run until the applications are published for opposition. *National Cable Television Association, Inc. v. American Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1431-1432 (Fed. Cir. 1991) and *DAK Industries, Inc. v. Daiichi Kosho Co., Ltd.*, 25 USPQ2d 1622 (TTAB 1992). In this case, opposer timely filed oppositions to the involved applications after publication of the marks, and thus, the defenses of laches, estoppel and acquiescence are not available to applicant here. In the facts of this case, however, none of those affirmative defenses are appropriate.

E.I. duPont de Nemours and Company v. duPont Publishing, Inc., ___ U.S.P.Q.2d ___ (Oppo. #91/109,415 Decided September 27, 2001, Page 36) (2001 TTAB 2001 Lexis 740). Decision at: www.uspto.gov/web/offices/com/sol/foia/ttab/2dissues/2001/109415.pdf

In this case, Opposer filed a timely Notice of Opposition against an ITU application. There can be no laches, estoppel or acquiescence under such circumstances, and thus none of these defenses can apply as a matter of law.

Furthermore, Opposer's principal allegation for this opposition is that the mark in question is descriptive or generic. Paragraph 19 alleges that Opposer's claim is barred by estoppel. However, "[i]t is well established that estoppel may not be asserted as a defense against a claim of mere descriptiveness." *Ohio State University v. Ohio University*, 51 U.S.P.Q.2d 1289 (TTAB 1999). Thus, Paragraphs 18-20 of the Answer should be stricken.

III. Paragraphs 22 and 23 Make Immaterial Allegations and Should be Stricken.

In the Notice of Opposition, Opposer set forth the basis for opposition as the desire, even the need, to be able to use the descriptive term “my store” in its business. Should a registration issue on such a descriptive term, Opposer would thereby be damaged, and thus Opposer meets the statutory standing requirement for filing this opposition (“Any person who believes that he, she or it would be damaged by the registration of a mark on the Principal Register may file an opposition addressed to the Trademark Trial and Appeal Board.” 37 C.F.R. §2.101(b)). As the Board has previously held:

When a plaintiff challenges a mark on the ground of descriptiveness and/or genericness, as is the case here, the plaintiff may establish its standing by pleading (and later proving) that it is engaged in the sale of the same or related products or services (or that the product or service in question is within the normal expansion of the plaintiff's business), and that the plaintiff has a competitive need or equal right to use the term in a descriptive manner, that is, that plaintiff is in a position to use the term descriptively.

James River Petroleum, Inc. v. Petro Stopping Centers, L.P., 57 U.S.P.Q.2d 1249 (TTAB 2000); see also *Interpayment Services Limited v. Docters & Thiede* ___ U.S.P.Q.2d ___ (Oppo #91/119,852 - Decided January 31, 2002) (TTAB 2002) (Copy attached)¹.

In this case, Opposer has pleaded that:

As part of Opposer's activities, Opposer SNOCAP provides facilities, website space, web pages and software and related e-commerce services and facilities, all of which allow individual, groups and bands to create, maintain and sell downloadable music and other digital entertainment files from personalized online shopping sites or stores known descriptively as “my stores” or “mystores”. Each such party can set up and conduct business using his or her personalized online store, which the user then identifies as “my store” or mystore, together with his or her name and/or the name of the band or group (if desired).

Opposition, ¶ 1; that:

¹ *James River Petroleum, Inc. v. Petro Stopping Centers, L.P.*, 57 U.S.P.Q.2d 1249 (TTAB 2000) was designated as Not Citable, but the decision was then cited by the TTAB for the issue for which it is referenced herein in *Interpayment Services v. Docters & Theide* (copy attached). In view of the current practice it is clearly relevant and citable, and should be controlling here.

Opposer SNOCAP's website FAQ (Frequently Asked Questions) page has specific instructions explaining to the user how to "Set Up My Store", and because the use of "My Store" and MyStore is so common in the online industry, Opposer is careful to specify that the user is creating an individualized SNOCAP store personal to that user, or a SNOCAP My Store (or a SNOCAP MyStore).

Opposition, ¶ 2; that the "mystore" mark is descriptive if not generic (Opposition, ¶¶ 4 and 5); and that several other companies are using "mystore" or "my store" in a descriptive (if not generic) fashion (Opposition ¶¶ 8 and 9). Any of these facts, if proven, would show Opposer "has a competitive need or equal right to use the term in a descriptive manner," *James River Petroleum, supra*, and therefore Opposer has standing. Thus, paragraph 22 of the Answer should be stricken.

In addition, Opposer has plead facts sufficient to show standing, and facts sufficient to show a valid ground exists for opposing registration. Accordingly, the Notice of Opposition is sufficient, and Applicant's claim the Notice fails to state a claim is improper. *Order Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 U.S.P.Q.2D 1221 (TTAB 1995). See also *S.C. Johnson & Son, Inc. v GAF Corp*, 177 USPQ 720 (TTAB 1973), Trademark Board Manual of Procedure §506.01, footnote 98: "affirmative defense of failure to state a claim upon which relief can be granted stricken since complaint did state such a claim".

Thus, paragraph 23 should be stricken from the Answer.

CONCLUSION

For the foregoing reasons, Paragraphs 14, 15, 18-20 22 and 23 should be stricken.

August 15, 2007

Respectfully submitted,
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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **APPLICANT'S MOTION TO STRIKE PORTIONS OF APPLICANT'S ANSWER AND AFFIRMATIVE DEFENSES** is being served on August 15, 2007, by deposit of same in the United States Mail, first class postage prepaid, in an envelope addressed to:

Erik M. Pelton
Erik M. Pelton & Associates, PLLC
PO Box 100637
Arlington, Virginia 22210

/Martin R Greenstein/
Martin R. Greenstein

LEXSEE

Interpayment Services Limited v. Docters & Thiede

Opposition No. 119,852

Trademark Trial and Appeal Board

2002 TTAB LEXIS 136

January 31, 2002, Decided

[*1]

Before Cissel, Wendel, and Rogers, Administrative Trademark Judges.

CORE TERMS: euro, opposer, symbol, summary judgment, currency, generic, trademark, electronic, descriptiveness, incapable, genericness, descriptive, software, on-line, debit, convert, pleaded, registration, similarities, resembles, amend, financial services, computer hardware, credit card, magnetically, registered, unpleaded, disperses, magazines, printouts

OPINION:

By the Board:

On August 9, 2000, Interpayment Services Limited filed a Notice of Opposition to registration of the mark set forth in Application Serial No. 75/671, 927 n1 on the grounds that (i) applicant's proposed mark, when used in connection with financial goods and services, so resembles opposer's previously used and registered design mark for banking services (Registration No. 1,666,064 n2) as to be likely to cause confusion, mistake or deception; and (ii) applicant's proposed mark is identical or substantially similar to the symbol adopted by the European Union for the euro, the new common European currency, and thus is incapable of acting as a trademark. The designs at issue in this case are reproduced below:

(euro \$)	(euro \$)	(euro \$)
Euro symbol n3	App. Serial No.	Reg. No.
	75/671,927	1,666,064

n1 Application Serial No. 75/671, 927 was filed on March 30, 1999 under Trademark Act Section 1(b) based on applicant's assertion of a *bona fide* intention to use the mark in commerce in connection with:

Computer software for use in on-line financial transactions; computer hardware and software that disperses and creates digital cash; magnetically encoded credit and debit cards (Int. Cl. 9).

Art prints and publications, namely magazines in the field of finance (Int. Cl. 16).

On-line financial transaction services, namely electronic cash transactions, electronic credit card transactions, and electronic debit transactions (Int. Cl. 36).

[*2]

n2 Registration No. 1,666,064 issued November 26, 1991 for "banking services, namely, issuance, collection, administration, and processing of travelers cheques, international money orders, negotiable bank drafts, checks, wire transfers, lines of credit" (Int. Cl. 36).

n3 In the general information provided to the public regarding its new currency ("EURO ESSENTIALS"), the European Union defines and provides examples of the graphic symbol for the euro. The image shown above was copied by the Board from the European Union's website at <http://europa.eu.int/euro/html>.

On August 13, 2001, opposer filed a motion seeking summary judgment on the grounds that applicant's proposed mark, because of its similarities to the euro symbol, is generic or merely descriptive of applicant's financial goods and services.

Construction of Pleadings

As noted above, the opposition was brought on the grounds that applicant's proposed mark is likely to be confused with opposer's previously used and registered mark, and that applicant's proposed mark so closely resembles the euro symbol as to be incapable of acting as a trademark. This latter ground does not clearly identify a legally cognizable [*3] basis for opposition.

To reach the merits of this case, we construe the pleaded claim that applicant's proposed mark is incapable of acting as a trademark as a claim that applicant's proposed mark is generic. n4 Specifically, we view the claim that applicant's mark so closely resembles the euro symbol as to be incapable of acting as a trademark as intended to assert that applicant's mark so closely resembles the euro symbol as to be considered the functional equivalent thereof, and generic when used in connection with applicant's financial goods and services, which, *inter alia*, convert other currencies into euros and euros into other currencies. n5 *See In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1557, 4 USPQ2d 1141 ("Generic terms, by definition incapable of indicating source, are the antithesis of trademarks, and can never attain trademark status").

n4 The pleaded claim that applicant's proposed mark is incapable of acting as a trademark also could be construed as a claim that the applicant's mark does not function as a trademark under §§ 1, 2, 3 and 45 of the Act. *See, e.g., In re Volvo Cars of North America, Inc.*, 46 USPQ2d (TTAB 1998) (DRIVE SAFELY held incapable of functioning as a mark); *In re Remington Products Inc.*, 3 USPQ2d 1714 (TTAB 1987) (PROUDLY MADE IN USA held incapable of functioning as a mark). However, insofar as the instant application is based on applicant's assertion of a *bona fide* intention to use the mark in commerce, a claim that the proposed mark fails to function as a trademark is premature. *See Michael S. Sachs, Inc. v. Cordon Art, B.V.*, 56 USPQ2d 1132 (TTAB 2000).

[*4]

n5 We note that this construction is supported by opposer's motion for summary judgment on the ground of genericness.

Applicant, in its answer, contends that opposer lacks standing to bring the genericness claim. In the Notice of Opposition, opposer asserts that it is "a financial services company that provides a variety of banking services in the United States and elsewhere in the world"; that opposer "provides international money transfer and foreign exchange services, including the issuance, collection, administration and processing of travelers cheques, international money orders, bank drafts, wire transfers, and lines of credit"; and that applicant's proposed mark "is identical or substantially similar to the symbol adopted by the European Union for the euro, the new common European currency". Accordingly, we find that opposer has pleaded its need to use the euro symbol in its financial services business and thus has pleaded facts that, if proven, would establish opposer's standing to oppose. *James River Petroleum, Inc. v. Petro Stopping Centers, L.P.*, 57 USPQ2d 1249 (TTAB 2000) ("When a plaintiff challenges a mark on the ground of descriptiveness [*5] and/or genericness, ... the plaintiff may establish its standing by pleading [and later proving] that it is engaged in the sale of the same or related products or services [or that the product or service in question is within the normal expansion of the plaintiff's business], and that the plaintiff has a competitive need or equal right to use the term in a descriptive manner...").

Motion For Summary Judgment

We turn to the motion for summary judgment on the grounds that applicant's proposed mark, because of its similarities to the euro symbol, is generic or merely descriptive of applicant's financial goods and services. On the ground of genericness, opposer argues that applicant's proposed mark is the generic symbol for the euro currency; that the euro symbol is generic for the central feature of goods and services that convert other currencies to euros or convert euros to other currencies; and that the term euros, or equivalent symbol [SEE ILLUSTRATION IN ORIGINAL], would be so recognized by the relevant purchasers as the generic symbol for currency conversion goods and services. Therefore, opposer asserts, it should be freely available for use by competitors of applicant. [*6]

In support of its motion, opposer submits 23 pages printed from the European Union's website in which the euro, its symbol, and its origin are discussed, including an enlarged version of the euro symbol reprinted earlier herein; a copy of the drawing page for application Serial No. 75/671, 927, with the mark also reprinted herein; one page from applicant's website showing use of applicant's proposed mark in connection with services offering an electronic currency whereby consumers can deposit US dollars to purchase items priced in Deutsch marks; the August 10, 2001 deposition testimony of Rob Docters, a partner in the applicant partnership, stating that applicant's services will license software that converts currency, including the euro; the declaration of Duncan Walker, General Counsel for opposer, stating that opposer and other financial services companies located in the United States and around the world use the euro symbol "to identify transactions or monetary valuations in that currency"; a series of printouts from webpages describing the efforts of computer and software businesses to offer customers the use of the euro symbol on their computers; and a series of newspaper articles [*7] indicating that the introduction of the euro and the euro symbol has received widespread publicity in the U.S. n6

n6 Under Fed. R. Civ. P. 56(e), the Board may permit the parties to supplement their summary judgment affidavits or to submit additional affidavits. We exercise our discretion under the rule in favor of considering the additional evidence offered with opposer's reply brief, namely the affidavit from opposer's attorney supporting opposer's summary judgment

evidence, including the web site printouts and Nexis articles. *See Shalom Children's Wear Inc. v. In-Wear A/S*, 26 USPQ2d 1516 (TTAB 1993).

In opposing entry of summary judgment for opposer on the claim that its proposed mark is generic, applicant argues that its mark is not identical to the euro symbol, but that, even if it were identical, applicant has not applied to register its mark for currency or negotiable instruments, and the record contains no evidence that the public perceives the euro symbol as generic when applied to computer software for use in on-line financial transactions; computer hardware and software that disperses and creates digital cash; magnetically encoded credit [*8] and debit cards; magazines in the field of finance; or on-line financial transaction services, namely electronic cash transactions, electronic credit card transactions, and electronic debit transactions.

In support of its position, applicant relies on the August 10, 2001 deposition testimony of Rob Docters, a partner in the applicant partnership, who describes how applicant's mark differs from the euro symbol, and states that applicant's services will support all established currencies, not just euros. Applicant also relies on printouts of PTO electronic records of 14 current or past trademark applications and certain registrations incorporating currency symbols. n7

n7 In each instance the degree of stylization of the marks, the presence of other elements in the marks, or the goods and services with which the marks are used, varied widely from the mark and goods at issue here. Thus, these trademark applications or registrations were accorded no weight in reaching our decision herein.

The burden is on the party moving for summary judgment to show the absence of a genuine issue of material fact, and that it is entitled to judgment as a matter of law. *See Fed. R. Civ. P. 56. [*9]* The Board may not resolve issues of material fact against the non-moving party. *See T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996); *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1993); and *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). To prevail on its motion for summary judgment, opposer must establish that there is no genuine issue of fact regarding the genus of the goods or services at issue and that the relevant consuming public understands applicant's proposed mark to refer primarily to that genus of goods or services. *See H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).

After careful consideration of the evidentiary submissions presented by each party, we find that no genuine issues [*10] of material fact exist and that applicant's proposed mark, even if considered identical to the euro symbol, is not generic for computer software for use in on-line financial transactions; computer hardware and software that disperses and creates digital cash; magnetically encoded credit and debit cards; magazines in the field of finance; or on-line financial transaction services, namely electronic cash transactions, electronic credit card transactions, and electronic debit transactions. The ample record evidence showing the public perception of the euro symbol shows a public association of the euro symbol as generic designation for a type of currency, and not for the goods and services with which applicant intends to use the proposed mark.

Accordingly, we find, *sua sponte*, that applicant is entitled to summary judgment in its favor on opposer's claim that applicant's mark is generic as applied to applicant's financial goods and services. That is, even though applicant has not filed a cross-motion for summary judgment on this

issue, we grant summary judgment to applicant, i.e. judgment on the claim that the mark is generic as applied to applicant's goods and services. *See The Clorox Co. v. Chemical Bank*, 40 USPQ2d 1098 (TTAB 1996); [*11] *Accu Personnel Inc. v. Accustaff Inc.*, 38 USPQ2d 1443 (TTAB 1996).

We turn to the motion for summary judgment on the ground that applicant's proposed mark, because of its similarities to the euro symbol, is merely descriptive of applicant's financial goods and services, which, *inter alia*, convert other currencies into euros and euros into other currencies. As noted above, the opposition was brought on the claims that applicant's proposed mark was likely to be confused with opposer's previously used and registered mark, and that applicant's proposed mark so closely resembled the euro symbol as to be incapable of acting as a trademark. While we construed the latter ground liberally, so as to be able to consider the motion for summary judgment on the claim of genericness, we find no references, express or implied, in the Notice of Opposition to Section 2(e)(1) or mere descriptiveness.

Notwithstanding the evidence submitted with opposer's motion for summary judgment regarding the descriptiveness of the euro symbol as applied to applicant's financial goods and services, a party may not obtain summary judgment on an issue which has not been pleaded. [*12] *See Fed. R. Civ. P. 56(a) and 56(b); Paramount Pictures Corp. v. White*, 31 USPQ2d 1768 (TTAB 1994). n8 However, rather than deny opposer's motion for summary judgment, we defer consideration until the issue of descriptiveness has been properly pleaded.

n8 An exception lies where the parties, upon summary judgment motion, have treated an unpleaded issue on its merits. However, as opposer acknowledges in its reply brief (p.1), applicant does not address the mere descriptiveness claim or opposer's supporting evidence in its response to the motion for summary judgment. Thus, the unpleaded claim of mere descriptiveness has not been treated on the merits and the Board cannot deem the pleadings to have been amended by agreement of the parties to allege mere descriptiveness.

Opposer is given leave to amend its pleading solely for the purpose of adding the claim that applicant's proposed mark, because of its similarities to the euro symbol, is merely descriptive of applicant's financial goods and services. n9

n9 A party which seeks summary judgment on an unpleaded issue may move to amend its pleading to assert the matter. *See Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993).

[*13]

Opposer is allowed 30 days from the date stamped on this order to file an amended notice of opposition as described above, failing which the remaining basis for the motion for summary judgment will be denied and discovery and trial dates will be reset only with regard to the Section 2(d) claim.

Applicant is allowed until 60 days from the date stamped on this order in which to file its answer to the anticipated amended pleading and its response to opposer's motion for summary judgment on the issue of mere descriptiveness. If opposer does not amend its pleading, applicant need not file either an amended answer or response to the motion. If opposer does amend its pleading and applicant fails to answer and contest the motion for summary judgment, then judgment may be entered against applicant on the descriptiveness claim.

Conclusion

To reprise the status of the various claims discussed herein, we note that the Section 2(d) claim awaits trial; that judgment has been entered in favor of applicant, the non-moving party, on the claim that the proposed mark is generic n10; that a claim under Trademark Act Sections 1, 2, 3 and 45 that the proposed mark fails to function as a trademark [*14] would be premature until there is use of the proposed mark in connection with the listed goods and services; and that opposer must amend the pleadings before the Board may consider the summary judgment motion on, or trial of, the claim that the mark is merely descriptive as applied to applicant's goods and services.

n10 The genericness claim is dismissed with prejudice.

Legal Topics:

For related research and practice materials, see the following legal topics:
Trademark LawLikelihood of ConfusionSimilarityAppearance, Meaning & SoundGeneral
OverviewTrademark LawU.S. Trademark Trial & Appeal Board
ProceedingsOppositionsGroundsTrademark LawU.S. Trademark Trial & Appeal Board
ProceedingsOppositionsStanding